UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

 a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This Office action is responsive to applicant's amendment filed September 17,

2004. Claims 1-26 are pending.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 3 recites the limitation "the limitation information" in lines 3-4. As this

limitation has been removed from independent claim 1, there is now insufficient

antecedent basis for the limitation in the claim.

Claim Rejections - 35 USC § 102

4.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

5.   Claims 1, 2, 9 and 11-17 are rejected under 35 U.S.C. 102(b) as being

anticipated by U.S. Patent 5,103,490 (McMillin).

Regarding claims 1, 2 and 9, McMillin discloses a data converting apparatus

comprising: a data converting part converting a set of image data that can be processed

by an image forming apparatus forming an image on a medium in accordance with the

set of image data (column 5, lines 24-41; column 6, lines 25-37); and a superimposing

part superimposing at least a first set of image data converted from a first set of input

data substantially prior to a time of printing (unmarked master stored (column 6, lines

25-29); retrieved prior to printing (column 6, lines 59-63)) and a second set of image

data converted from a second set of input data different from the first set of input data,

the second set of input data including non-image data (response-marked form, including

non-image data such as characters (Fig. 2b) also retrieved from storage (column 6,

lines 59-63), to generate a single set of superimposed image data (column 6, lines 63-

67)), wherein the image forming apparatus forms an image on the medium based on the

single set of superimposed image data (column 6, lines 38-56), and wherein the

superimposing part superimposes the first and second sets of image data substantially

when the image forming apparatus receives a command to form the image on the

medium (superimposing responsive to retrieval request (Fig. 4)). The data converting

apparatus further comprises a data sending part sending the single set of superimposed

image data to the image forming apparatus (column 6, lines 57-67); and a previewing

part previewing the single set of superimposed image data generated by the

superimposing part (column 6, lines 63-68).

Claims 11, 12 and 17 are method claims corresponding to above-rejected

apparatus claims 1, 2 and 9, respectively. The steps corresponding to the limitations

recited in the apparatus claims are disclosed in McMillin, as set forth above.

Regarding claims 13-16, McMillin further discloses steps of superimposing at

least one set of image data over another set of image data that is converted from the

set of input data and stored as a predetermined form (column 5, lines 24-30); selecting

a desired form from at least one predetermined form and superimposing at least one set

of image data over the desired form (column 7, lines 18-21); enabling changing of the

predetermined form by changing of layout information that indicates a position where

the predetermined form is formed on the medium and is stored by associating with the

predetermined form (column 10, lines 3-42).

Claim Rejections - 35 USC § 103

6.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

7.   Claims 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

McMillin.

        Claims 19-25 recite the steps of above-rejected method claims 11-17,

respectively, as a program recorded on a computer-readable medium. Storage of a

program for performing image processing steps in general, while not taught by McMillin,

is well known in the art, and it would have been obvious for one of ordinary skill in the

art to provide a program for performing the steps taught by McMillin so that such step

may be performed by a computer, without requiring specific image processing hardware

for performing each of the steps.

8.   Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

McMillin as applied to claim 1 above, and further in view of U.S. Patent 6,594,405

(Flannery).

        McMillin does not disclose storing limitation information by associating with a

predetermined form, as recited in claim 3. Flannery, as set forth on page 3 of the Office

action mailed May 17, 2004, discloses a method and apparatus for combining

foreground and background information on a preprinted form (read Abstract), wherein

limitation information is used and stored in association with a predetermined form

(parameters limiting paper size, number of pages in a form, may be stored for later

retrieval (column 4, lines 20-28)). By providing such information, a user can provide a

composite image in a suitable manner in accordance with specific requirements

regarding a size or number of pages, and thus it would have been obvious for one of

ordinary skill in the art to provide a means or step of providing and storing limitation

information, such as disclosed by Flannery, in the apparatus disclosed by McMillin.

Apart from the above-mentioned storage of limitation information, claims 3, 5, 6

are method claims corresponding to above-rejected apparatus claims 13-15,

respectively. The limitations corresponding to the steps recited in the method claims

are disclosed in McMillin, as set forth above.

Regarding claims 4 and 7, the form storing part of McMillin further comprises a

registration part registering the set of image data as a predetermined form that is

superimposed (column 5, lines 24-30); and a store control part selectively storing the

predetermined form changed by the form changing part (column 10, lines 3-42). Further

regarding claim 8, the form changing part changes layout information of the

predetermined form on the medium, which information the form storing part stores by

associating with the predetermined form, as mentioned above with respect to claim 16.

9.   Claims 10 18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable

over McMillin in view of U.S. Patent 6,370,280 (Cok et al.).

Regarding claim 10, McMillin discloses a data converting apparatus comprising: a data converting part converting a set of input data into a set of image data that can be processed by an image forming apparatus forming an image on a medium in accordance with the set of image data (column 5, lines 24-41; column 6, lines 25-37); a superimposing part superimposing at least two sets of image data converted from at least two different sets of input data to generate a single set of superimposed image data, wherein the image forming apparatus forms an image on the medium based on the single set of superimposed image data (column 6, lines 38-56); and a form storing part selectively storing the set of image data converted from the set of input data as a predetermined form that is superimposed (column 5, lines 24-30).

McMillin does not disclose a limiting part limiting use of the predetermined form in accordance with limitation information that the form storing part stores associated with the predetermined form, wherein the limitation information includes permission of a user to initiate superimposing by the superimposing part. Cok et al. disclose a system for producing composite images, wherein production of composite images may be permitted or inhibited on the basis of customer identification (column 3, lines 36-48; column 4, lines 21-48). By requiring such limiting information, unauthorized use may be prevented (column 4, lines 43-48), thereby enhancing the security of the system. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of McMillin by providing a limiting part such as disclosed in Cok et al.

Claim 18 is a method claim corresponding to above-rejected apparatus claim 10.
The steps corresponding to the limitations recited in the apparatus claim is disclosed in
the combined teaching of McMillin and Cok et al., as set forth above.

Claim 26 recites the steps of above-rejected method claim 18 as a program
recorded on a computer-readable medium. Storage of a program for performing image
processing step in general, while not taught by McMillin, is well known in the art, and it
would have been obvious for one of ordinary skill in the art to provide a program for
performing the steps taught by McMillin so that such steps may be performed by a
computer, without requiring specific image processing hardware for performing each of
the steps.

Response to Arguments

10.   Applicant's arguments filed in response to the prior rejection of the above claims
as set forth in the Office action mailed May 17, 2004 have been fully considered but
they are not persuasive.

Applicant asserts, on page 9 of applicant's response, that McMillin does not
teach or suggest "superimposing at least a first set of image data converted from a first
set of input data substantially prior to a time of printing and a second set of image data
converted from a second set of input data different from the first set of input data, the
second set of input data including non-image data," because McMillin teaches that both
the first and second sets of image data are formed from scanned in image data.
However, the claims do not state that one of the two sets is not "scanned in" image
data. The only requirements of the two sets of image data are that the second set of

image data is different from the first set, and that the second set includes non-image

data. In McMillin, the second set of image data is clearly different from the first set in

that the first set is an unmarked master form, while the second set is a response-

marked form (note Figs. 2a and 2b). The second set includes non-image data in the

form of characters, not unlike those shown in Fig. 9 of applicant's drawings.

Applicant further states, on page 9 of applicant's response, that Flannery does

not teach or suggest superimposing "the first and second sets of image data

substantially when the image forming apparatus receives a command to form the image

on the medium." This limitation is disclosed in McMillin, however (superimposing

responsive to retrieval request (Fig. 4)).

Applicant asserts, on page 10 of applicant's response, that McMillin does not

disclose superimposing "two different sets of image data in accordance with limitation

information showing a limitation of use so that at least one set of image data ... or

storing the limitation information by associating with the predetermined form," and that

Flannery "only teaches parameters limiting paper size of the number of pages in a form,

for example, but it does not teach or suggest that 'the limiting information includes

permission of a user to initiate the superimposing by the superimposing part.'" These

limitations are disclosed in Cok et al., as mentioned above with respect to the rejection

of claims 10, 18 and 26.

Conclusion

11.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-

4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate

Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
January 21, 2005